

REMARKS**I. General**

Claims 1-23 and 35-51 are pending in the current application. Claims 1-23 and 35-51 are rejected. The issues asserted in the Office Action mailed December 24, 2003 are:

- The drawings are objected to under 37 CFR 1.84(p)(5) because they include reference signs not mentioned in the description;
- The use of the trademark FIRST DATA CORP. is noted and should be capitalized wherever it appears;
- Claims 19-23 and 41-51 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention;
- Claims 1-3, 5, 41, 43-45, and 48-50 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,790,677 to Fox et al. (hereinafter *Fox*);
- Claims 4, 6-23, 42, 46, 47, and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fox*; and
- Claims 35-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fox* in view of U.S. Patent No. 5,701,343 to Takashima et al. (hereinafter *Takashima*).

II. Specification Amendments

Applicants have amended the specification to include the reference signs “709” and “907” that were mistakenly left out of the specification. Thus, reference sign “702” on line 18 of page 19 was replaced with reference sign “709,” and reference sign “907” was added to line 15 of page 22 where it was inadvertently left out. No new matter has been added by these amendments.

The specification was also amended to capitalize every use of “FIRST DATA CORP.” where it was previously used without capitalization. No new matter is added by the specification amendments.

III. Claim Amendments

Claim 19 is amended to correct a claim informality wherein “said cryptography services module” is replaced with “said second cryptography services module” for which antecedent basis is present in claim 3 from which claim 19 indirectly depends. New

dependent claims 52-57 have been added which recite aspects related to the configuration information as found in the specification at pages 17, 20, 21, 23, and 24. Support for the patentability of new claims 52-57 is discussed within the body of this amendment. No new matter is added by the claim amendments.

IV. Drawing Objections

The Examiner objected to the drawings under 37 CFR § 1.84(p)(5) stating that various reference signs (“709” of Figure 7B and “907” of Figure 9) included in the drawings are not mentioned in the description. In response, Applicants have amended the specification to include these reference signs. Accordingly, Applicants believe no drawing amendments are required in response to the outstanding Office Action.

V. Specification Objections

Use of Trademarks in Application

The Examiner noted Applicants use of FIRST DATA CORP. in the specification. In response, Applicants have amended the specification so that all uses of this trademark are capitalized.

Request for new application papers with double spaced lines

Applicants respectfully submit that the application was filed with 1 ½ line spacing as provided for under 37 CFR § 1.52 and therefore is in proper format for examination. Specifically, 37 CFR § 1.52 (b)(2)(i) provides that the specification must have lines that are 1 ½ or double spaced. Thus, the specification meets the requirements of 37 CFR § 1.52 (b)(2)(i), and Applicants respectfully assert that they should not be required to submit new application papers with lines that are double spaced.

VI. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 19-23 and 41-51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In making this rejection, the Examiner rejects claim 19 due to lack of antecedent basis. Claim 19 has been amended so that “said cryptography services module” is replaced with “said second cryptography services

module” where antecedent basis is present in claim 3 from which claim 19 indirectly depends.

The Examiner also rejected claim 41, asserting that claim 41 provides for the use of a transaction processing device for providing financial services processing, but is indefinite because claim 41 does not set forth any steps involved in the providing financial services processing. (Office Action, page 4). Applicants respectfully assert that the addition of steps to define the statement “providing financial services processing” is not required. The providing of financial services is a functional limitation used to define the transaction processing device by what it does. There is nothing objectionable with defining some part of an invention in functional terms, and functional language does not in and of itself, render a claim improper. See M.P.E.P. §2173.05(g) citing *In re Swinehart*, 439 F.2d 210. Moreover, the Examiner is reminded that the test for definiteness under 35 U.S.C. § 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. M.P.E.P. §2173.02 citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). The specification clearly states that the system for configuration of the transaction device may be used for financial services, such as credit card processing, check processing, check verification, debit card processing, and for private label card processing according to embodiments of the invention. (Specification, page 24). Thus, one of skill in the art would understand what is meant by a transaction processing device for providing financial services processing when read in light of the specification. Therefore, all the elements of claim 41 must be given patentable weight, and the statements relating to a transaction processing device for providing financial services processing cannot be ignored simply because the Examiner believes that steps involved in providing financial services processing should be included with claim 41.

Based on the arguments presented above, Applicants respectfully request the Examiner to withdraw the rejection of claims 19-23 and 41-51 under 35 U.S.C. § 112, second paragraph.

VII. Rejection under 35 U.S.C. § 102 (b) – *Fox*

Claims 1-3, 5, 41, 43-45, and 48-50 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by *Fox*. Applicants respectfully traverse this rejection and assert that the rejected claims are allowable at least for the reasons stated below.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. M.P.E.P. §2131. Applicants respectfully assert that the rejection does not satisfy this requirement.

Failure to teach every element of the claim**A. Independent Claims****Claim 1**

Claim 1 requires, in part:

a remote configuration server, wherein said configuration server is capable of communicating securely with said transaction processing device via a public communications network, wherein said transaction processing device is capable of communicating securely with said configuration server via said public network, and wherein said transaction processing device is capable of being remotely configured by said configuration server via said public communications network. (emphasis added)

The disclosure of *Fox* fails to disclose the foregoing. The Examiner asserts that the disclosure of *Fox* appearing at column 2, lines 8-52 meets this portion of claim 1. The cited portion of *Fox* discloses an electronic commerce system for the commercial interchange of documents and instruments in a large audience of participants wherein the system has a credential binding server at a trusted credential authority and multiple computing units at associated participants. (*Fox*, col. 2, lns 8-15). The participants and trusted credential authority are interconnected by a communication system. Participants of the system register with the trusted credential authority for a right to participate in the electronic commerce system. (*Fox*, col. 2, lns 23-26). Registration is accomplished by the computing unit generating and sending a registration packet that is encrypted over the communication system to the credential binding server. (*Fox*, col. 2, lns 26-30). The credential binding server will

decrypt the packets and produce a unique credential for each registering participant so that the participants are able to participate in commercial activity. (*Fox*, col. 2, lns 32-40). The credential is unique to a particular participant, and will be used in future transactions as a means to identify the participants and for authenticating the participants to each other. (*Fox*, col. 11, lns 14-22). By sending a credential, the binding server is merely providing the participants evidence of the participant's right to use the commerce system.

The generation and sending of a credential as discussed in *Fox* does not disclose a transaction processing device that is remotely configured by said configuration server over the public communications network. In contrast to the system of *Fox*, the transaction processing device of the claim is remotely and securely configured (e.g. provided with a merchant's account number, telephone number to access the processing network, passwords, business information, and/or information as it appears on a customer's receipt) for use in processing transactions. (Specification, page 2, lines 10-14; page 17, line 19 through page 18, line 4). Moreover, remote configuration of a transaction processing device of embodiments of the present invention may further allow software modules to be added, replaced, or removed from the transaction processing device. (specification, page 20). The creation and use of a credential does not teach or disclose the ability of the transaction processing device to be remotely configured by the configuration server as recited in the claim. Thus, *Fox* fails to disclose all the elements of claim 1, and therefore, Applicants respectfully request that the 35 U.S.C. § 102 rejection for claim 1 be withdrawn.

Claim 41

Claim 41 requires, in part:

a remote configuration server, wherein said configuration server securely communicates with said transaction processing device via said public data network to remotely configure said transaction processing device for use by a particular subscriber account in providing said financial services. (emphasis added)

The disclosure of *Fox* fails to disclose the foregoing. In rejecting claim 41, the Examiner asserts that the disclosure of *Fox* found at column 22, line 48 to column 23, line 55 teaches that the system of *Fox* may configure particular user accounts. (Office Action, page 5). However, the cited portion discloses an electronic credit card system having a registration phase and an order and purchase processing phase. The system includes several participants

and a trusted authority/ binder. (*Fox*, col. 22, lns 48-55). Each participant is equipped with a computing unit where each computing unit is loaded with a credit card application and cryptography system to support the credit card application. During registration, each participant will request and receive credentials from the trusted authority/ binder. (*Fox*, col. 22, lns 60-67). The credentials for the merchant and acquirer are created by the binder as authorized from their responsible bank, and credentials for the purchaser are created by the binder as authorized by the purchaser's bank. The credentials for the cardholder are created when the purchaser requests registration of the credit card wherein the credentials for the cardholder includes various types of information, such as a credential serial number, the cardholder's name, credential expiration, etc. (*Fox*, col. 23, lns 5-35).

The disclosure in *Fox* of the registration process of a merchant and cardholder and the information that makes up a cardholder credential fails to disclose a remote configuration server that remotely and securely configures the transaction processing device. For example, the remote configuration server according to embodiments of the invention can configure the transaction processing device to be used in processing transactions by providing a merchant's account number, providing a telephone number to access the processing network, provide business information, and/or provide passwords to the transaction processing device. (Specification, page 2, lines 10-14; page 17, line 19 to page 18, line 4). Yet, the disclosure of information comprising a credential along with a merchant registration process fails to teach or disclose a remote configuration server, wherein the configuration server securely communicates with the transaction processing device to remotely configure the transaction processing device for use by a particular subscriber account in providing financial services. Thus, *Fox* fails to disclose all the elements of claim 41, and therefore, Applicants respectfully request that the 35 U.S.C. § 102 rejection for claim 41 be withdrawn.

B. Dependent Claims

Claims 2, 3, 5, 43-45, and 48-50 depend directly or indirectly from their respective base claims 1 and 41 and thereby inherit all of the limitations of their respective base claims. Accordingly, it is respectfully submitted that the dependent claims 2, 3, 5, 43-45, and 48-50 are patentable over the 35 U.S.C. § 102 rejection based on *Fox*. In addition to their dependency from base claims 1 and 41, the dependent claims are allowable based on further

limitations recited therein. Specific examples of such additional limitations present in the dependent claims which are not found in the applied art are set forth below.

Claim 50

Claim 50 requires, in part:

wherein said transaction processing device comprises control circuitry selecting communication via said public data network and said private data network.

The disclosure of *Fox* fails to disclose the foregoing. *Fox* discloses an electronic commerce system for the commercial interchange of documents and instruments in a large audience of participants wherein the system has a credential binding server at a trusted credential authority and multiple computing units at associated participants. (*Fox*, col. 2, lns 8-15). The computing units and binding server is interconnected via one or more communication systems. (*Fox*, col. 5, lns 64-66). In addition, *Fox* discloses that the communication systems can be embodied as either a wire-based or wireless network. (*Fox*, col. 5, lns 66-67). However, the mere disclosure that a communication system can be wireless or wired fails to disclose a transaction processing device that comprises control circuitry for selecting communication via a public data network and a private data network. Thus, *Fox* fails to disclose all the elements of claim 50.

New Claims 52, 53, and 57

New claims 52, 53, and 57 require, in part:

configuration data transmitted from said remote configuration server to said transaction processing device wherein said configuration data is stored on said remote configuration server and comprises transaction processing device settings used for the initial setup of said transaction processing device.

New claims 52, 53, and 57 are patentable because the disclosure of *Fox* fails to disclose the foregoing. *Fox* discloses a credential, but the disclosure of a credential fails to disclose or suggest configuration data that is transmitted from the configuration server to the transaction processing device where the configuration data is stored on the configuration server and comprises settings of the transaction processing device that are used for the initial setup of the transaction processing device. Thus, *Fox* fails to disclose all the elements of new claims 52, 53, and 57.

New Claim 54

New claim 54 requires, in part:

said remote configuration server comprises:

a configuration module comprising:

a database services module wherein said database services module is capable of storing configuration data; and

a software module wherein said software module determines if configuration data about said transaction processing device is stored on said database services module.

New claim 54 is patentable because the disclosure of *Fox* fails to disclose the foregoing. *Fox* discloses a credential binding server, but the disclosure of a credential binding server fails to disclose or suggest a remote configuration server that comprises a configuration module that comprises a database services module capable of storing configuration data, and a software module that determines if configuration data about the transaction processing device is stored on the database services module. Thus, *Fox* fails to disclose all the elements of new claim 54.

VIII. Rejection under 35 U.S.C. § 103 (a) – *Fox*

Claims 4, 6-23, 42, 46, 47, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fox*. Applicants respectfully traverse this rejection and assert that the rejected claims are allowable at least for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See MPEP §2143. Without conceding any other criteria, Applicants respectfully assert that the rejection does not satisfy the first and third criteria, and therefore, the claims are patentable under 35 U.S.C. § 103(a).

A. Lack of Proper Motivation

The Examiner concedes that *Fox* does not specifically teach all the elements of claims 4, 6-23, 42, 46, 47, and 51. Therefore, the Examiner relies on assertions of official notice to provide the elements that are not present in *Fox*. However, proper motivation is required in order to combine or modify references for an obviousness rejection under 35 U.S.C. §103.

It is well settled that the prior art must suggest the desirability of the claimed invention and motivation to make such combinations can not be found in the applicant's disclosure. MPEP §2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). However, a mere assertion of official notice to disclose the elements missing from the teachings of *Fox* does not establish the presence of a suggestion within the prior art to achieve the claimed combination. Additionally, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the level of skill in the art. MPEP §2143, citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner has shown no such suggestion, and the motivation supplied in the Office Action to achieve the existence of a communications protocol stack to facilitate communications over a communications network wherein the stack is a TCP/IP stack, the existence of a communications protocol stack implemented in hardware, and the existence of cryptographic services implemented in hardware as required by claims 4, 46, and 47 respectively, is simply derived from an assertion of official notice along with a statement that it would have been obvious to one of ordinary skill in the art. As such, the Examiner has failed to establish proper motivation to combine *Fox* with the assertions of official notice. Thus, claims 4, 6-23, 42, 46, and 47 are patentable over the 35 U.S.C. §103(a) rejection of record.

B. Failure to teach or suggest all claim limitations

Base claims 1 and 41 are patentable due to the deficiencies of *Fox* as discussed above. The Examiner has not relied upon any other references that disclose these deficiencies. Claims 2-23, 42-55, and 57 depend directly or indirectly from their respective base claims 1 and 41, and thus, inherit all limitations of their respective base claims 1 and 41. Therefore, the cited reference fails to teach all the elements of claims 2-23, 42-55, and 57, and thus, claims 2-23, 42-55, and 57 are patentable under 35 U.S.C. § 103(a). In addition to their dependency from base claims 1 and 41, dependent claims 2-23, 42-55, and 57 are also allowable based on further limitations recited therein. Specific examples of additional

limitations present in the dependent claims which are not found in the applied art are set forth below.

Claim 7

Claim 7 requires, in part:

a configuration module, wherein said second cryptographic services module is part of said configuration module.

The disclosure of *Fox* fails to disclose the foregoing. In rejecting claim 7, the Examiner merely asserts that “the credential binding server is a configuration module,” but the Examiner fails to state which portion of *Fox* is relied upon in rejecting claim 7. Thus, Applicants assume the Examiner relied on the portions of *Fox* discussed below in rejecting claim 7. *Fox* discloses an electronic commerce system for the commercial interchange of documents and instruments in a large audience of participants wherein the system has a credential binding server at a trusted credential authority and multiple computing units at associated participants. (*Fox*, col. 2, lns 8-15). Participants of the system register with the trusted credential authority for a right to participate in the electronic commerce system, and the credential binding server will issue a unique credential for each registering participant so that the participants are able to participate in commercial activity. (*Fox*, col. 2, lns 23-40). However, the generation and sending of a credential does not disclose a configuration module, wherein the second cryptographic services module is part of the configuration module. Thus, *Fox* fails to disclose all the elements of claim 7, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claim 7 be withdrawn.

Claims 11, 13 and 15

Claims 11 and 15 require, in part:

wherein said terminal certificate is stored in said first cryptographic services module.

Claim 13 requires, in part:

wherein said terminal certificate is stored in said second cryptographic services module.

The disclosure of *Fox* fails to disclose the foregoing. In rejecting the foregoing portions of claims 11, 13, and 15, the Examiner merely asserts that “the credential binding

server issues certificates for each transaction processing device, and sends them to the respective terminals,” but the Examiner fails to state which portion of *Fox* is relied upon in rejecting this portion of claims 11, 13, and 15. Thus, Applicants assume the Examiner relied on the portions of *Fox* discussed below in rejecting claims 11, 13, and 15. *Fox* discloses a binding server that generates a credential which is unique to a particular participant and will be used in future transactions as a means for identifying the participants and for authenticating the participants to each other. (*Fox*, col. 11, lns 15-18). However, the disclosure of a credential does not teach or suggest a terminal certificate that is stored in either the first or second cryptographic services module. Thus, *Fox* fails to disclose all the elements of claims 11, 13, and 15, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claims 11, 13, and 15 be withdrawn.

Claims 10, 12, 14, and 16

Claims 10, 12, 14, and 16 require, in part:

wherein said certificate manager issues a server certificate to said configuration server;

wherein said server certificate is stored in said second cryptographic services module.

The disclosure of *Fox* fails to disclose the foregoing. The Examiner asserts that column 11, lines 24-38 discloses this portion of claims 10, 12, 14, and 16. A review of cited portion reveals that *Fox* discloses that the credential binding server will attach a digital signature to the credential wherein the digital signature is generated by encrypting a hash of the credential using the private key of the trusted credential authority. (*Fox*, col. 11, lns 24-28). After the credential is digitally signed, it is sent from the binding server to the individual computing units. (*Fox*, col. 11, lns 31-38). Thus, *Fox* teaches that the binding server creates a credential, signs it, and then sends it to the participants. However, this does not teach a certificate manager that issues a server certificate to the configuration server where the server certificate is stored in the second cryptographic services module. Thus, *Fox* fails to disclose all the elements of claims 10, 12, 14, and 16, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claims 10, 12, 14, and 16 be withdrawn.

Claims 18-23 and New Claim 55

Claims 18-23 and new claim 55 require, in part:

said configuration server comprises:

a certificate manager communicatively connected to said transaction processing device, wherein said certificate manager issues a terminal certificate to said transaction processing device;

a security services module, wherein said security services module extracts a public key of said transaction processing device from said certificate of said transaction processing device to authenticate said transaction processing device.

The disclosure of *Fox* fails to disclose the foregoing. In making this rejection, the Examiner asserts column 10, lines 50-55, in rejecting these portions of claims 18-23. The cited portion relates to the registration process wherein the credential binding server verifies the authenticity of the registration packets sent by the participants to the server. (*Fox*, col. 10, lns 40-44). In addition, *Fox* teaches that the registration packet is generated by the computing unit. (*Fox*, col. 2, lns 25-28; col. 8, lns 28-35). Thus, *Fox* teaches that the credential binding server will decrypt and verify data contained in the registration packet generated and sent by the computing unit to the credential binding server. (*Fox*, col. 10, lns 44-55). However, as shown above, claims 18-23 and new claim 55 require the configuration server to issue a terminal certificate (what the Examiner reads as information sent during the registration process of *Fox*) to the transaction processing device (what the Examiner reads as the computing unit of *Fox*) wherein the security services module of the configuration module will extract a public key from the terminal certificate that was previously generated by the certificate manager of the configuration server. Yet, *Fox* teaches that the information decrypted is information that was originally generated by the computing unit for registration, and thus, this information generated by the computing unit is not information that was generated by the credential binding server. As such, *Fox* teaches the decryption of data generated from a computing unit and does not teach a configuration module that includes a security services module, wherein the security services module extracts a public key of the transaction processing device from the terminal certificate of said transaction processing device. Thus, *Fox* fails to disclose all the elements of claims 18-23 and new claim 55, and therefore, Applicants respectfully assert that claims 18-23 and new claim 55 are patentable under 35 U.S.C. § 103.

New Claim 55

New claim 55 further requires, in part:

configuration data comprises at least one of:
a subscriber's logo;
a subscriber's business name;
a subscriber's terminal identifying monikers;
a subscriber's address;
a subscriber's telephone number;
a subscriber's URL;
a subscriber's fax number; and
a subscriber's email address.

New claim 55 is patentable because the disclosure of *Fox* also fails to disclose the foregoing. *Fox* discloses a credential that is sent to a participant. However, the disclosure of a credential fails to disclose or suggest configuration data that comprises at least one of a subscriber's logo, a subscriber's business name, a subscriber's terminal identifying monikers, a subscriber's address, a subscriber's telephone number, a subscriber's URL, a subscriber's fax number, and a subscriber's email address. Thus, *Fox* fails to disclose all the elements of new claim 55.

Claim 51

Claim 51 requires, in part:

said transaction processing device comprises control circuitry selecting communication via said public data network and said private data network wherein selection of communication via one of said public data network and said private data network is based upon information associated with a particular financial service transaction then being processed. (emphasis added)

The disclosure of *Fox* fails to disclose the foregoing. In rejecting claim 51, the Examiner takes Official Notice that the method of sending packets through different interfaces depending upon destinations in order to reduce transmission time, cost, or network congestion is well known in the art. However, this Official Notice fails to teach or suggest a transaction processing device that comprises control circuitry selecting communication via the public data network and the private data network wherein the selection of communication via one of the public data network and the private data network is based upon information associated with a particular financial service transaction then being processed.

Furthermore, Applicants respectfully traverse the Examiner's assertion of Official Notice, and under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for this assertion of Official Notice. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 51 should be withdrawn. Moreover, Applicants respectfully point out that it is never appropriate for the Examiner to rely solely on "common knowledge" in the art without evidentiary support in the record, as principal evidence upon which a rejection is based. M.P.E.P. §2144.03 citing *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Thus, the Examiner has failed to establish the presence of all elements of claim 51 in the applied art, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claim 51 be withdrawn.

IX. Rejection under 35 U.S.C. § 103 (a) – *Fox & Takashima*

The Examiner rejected claims 35-40 as being unpatentable over *Fox* in view of *Takashima*. Applicants respectfully traverse this rejection and assert that the rejected claims are allowable at least for the reasons stated below.

Failure to Clearly Communicate Findings for Rejection

Applicants would like to point out that although the Examiner has indicated that claim 35 is rejected in the Office Action, the mere assertion that "*Fox* discloses all the limitations therein" (Office Action, page 9) is not consistent with office policy. Accordingly, Applicants respectfully point out that whenever, on examination, any claim for a patent is rejected, the Examiner must provide notification of the reasons for rejection together with such information and references as may be useful in judging the propriety of continuing the prosecution. 35 U.S.C. § 132. The Examiner is also required to ***clearly communicate*** findings, conclusions, and reasons which support all proposed rejections. M.P.E.P. 2106 (VII).

As such, the Examiner has not specifically articulated the rejection of claim 35 and has failed to clearly communicate findings for rejections early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity. M.P.E.P. §706. Thus, in accordance with the requirements under M.P.E.P. §§706 and 2106 (VII), Applicants respectfully request that if

the Examiner maintains the current rejection of claim 35, that he identify the specific portions of the applied art which meets the elements of claim 35 so that that Applicants may have a full and fair opportunity to explore the patentability of this claim.

Furthermore, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art cited must teach or suggest all the claim limitations. M.P.E.P. § 2143. Applicants respectfully assert that the cited references do not teach or suggest all the claim limitations of claims 35-40, and therefore, the claims are patentable under 35 U.S.C. § 103(a).

Failure to teach every element of the claim

A. Independent Claim

Claim 35

Claim 35 requires, in part:

authenticating said configuration server to said transaction processing device, if said configuration server includes configuration data about said transaction processing device.

The disclosure of *Fox* in combination with *Takashima* fails to disclose the foregoing. The Examiner fails to state which portion of *Fox* is relied upon in rejecting this portion of claim 35. Thus, Applicants assume the Examiner relied on the portions discussed below in rejecting claim 35. *Fox* discloses an electronic commerce system for the commercial interchange of documents and instruments in a large audience of participants wherein the system has a credential binding server at a trusted credential authority and multiple computing units at associated participants. (*Fox*, col. 2, lns 8-15). Participants of the system register with the trusted credential authority for a right to participate in the electronic commerce system. (*Fox*, col. 2, lns 23-26). Registration is accomplished by the computing unit generating and sending a registration packet over the communication system to the credential binding server. (*Fox*, col. 2, lns 25-30; col. 8, lns 28-35). After the computing unit registers with the credential binding server, the credential binding server will generate a credential that contains a digital signature of the trusted credential authority. (*Fox*, col. 11, lns 10-25). The digital signature will be used by participants during transactions of the commerce system to verify that communications are between authorized participants who have properly registered with a trusted credential authority. (*Fox*, col. 11, lns 30-37). Thus, *Fox* teaches that the credential binding server sends unique credentials containing digital

signatures, operating to verify authorized communications among participants, to the computing units after the computing units have registered with the credential binding authority. However, *Fox* fails to teach or suggest authenticating the configuration server to the transaction processing device, if the configuration server includes configuration data about the transaction processing device. Moreover, *Takashima* fails to disclose this deficiency. Thus, the cited references fail to disclose all the elements of claim 35, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claim 35 be withdrawn.

Claim 35 also requires:

- providing said configuration data to said transaction processing device by said configuration server;
- receiving by said configuration server an acknowledgment from said transaction processing device; and
- storing said received information including said configuration data by said configuration server.

The disclosure of *Fox* in combination with *Takashima* fails to disclose the foregoing. The Examiner fails to state which portion of *Fox* is relied upon in rejecting this portion of claim 35. Thus, Applicants assume the Examiner relied on the portions discussed below in rejecting this portion of claim 35. *Fox* discloses an electronic commerce system that includes a credential binding server that generates a credential that is unique to a particular participant and will be used in future transactions as a means for identifying the participants and for authenticating the participants to each other. (*Fox*, col. 11, lns 14-25). The unique credentials are also used to provide the participants with the right to participate in commercial activity. (*Fox*, col. 2, lns 23-40). However, the use of a credential does not disclose configuration information that is sent from the configuration server to the transaction processing device. Moreover, claim 35 requires that the acknowledgement received from the transaction processing device and the configuration data both be stored by the configuration server. However, *Fox* fails to disclose that the configuration server stores the received acknowledgement information and the configuration data. Furthermore, *Takashima* fails to disclose this deficiency. Thus, the cited references fail to disclose all the elements of claim 35, and therefore, Applicants respectfully request that the 35 U.S.C. § 103 rejection for claim 35 be withdrawn.

B. Dependent Claims

Claims 36-40 and new claim 56 depend directly or indirectly from base claim 35 and thereby inherit all of the limitations of base claim 35. Accordingly, it is respectfully submitted that the dependent claims 36-40 and new claim 56 are allowable based on at least their dependency from independent base claim 35 for at least the reasons discussed above. Thus, Applicants respectfully submit that based on the arguments above, claims 36-40 and new claim 56 are patentable under 35 U.S.C. §103. In addition to their dependency from base claim 35, dependent claims 36-40 and new claim 56 are also allowable based on further limitations recited therein. Specific examples of additional limitations present in the dependent claims which are not found in the applied art are set forth below.

New Claim 56

New claim 56 requires, in part:

wherein said configuration data provided to said transaction processing device by said configuration server comprises transaction processing device settings used for the initial setup of said transaction processing device.

New claim 56 is patentable because the disclosure of *Fox* in combination with *Takashima* fails to disclose the foregoing. *Fox* discloses a credential that is sent to a participant. However, the disclosure of a credential fails to disclose or suggest that the configuration information that is provided to the transaction processing device comprises device settings of the transaction processing device that are used for the initial setup of the transaction processing device. *Takashima* fails to disclose this deficiency. Thus, the combination of *Fox* and *Takashima* fails to disclose all the elements of new claim 56.

X. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

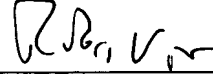
Application No.: 09/588,367

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Applicant notes that the Commissioner is authorized to charge Deposit Account No. 06-2380, under Order No. 56728-P001US-10001505 for the amount of \$54.00 due to the addition of the new dependent claims.

Dated: March 24, 2004

Respectfully submitted,

By 

R. Ross Viguet

Registration No.: 42,203

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8000

(214) 855-8200 (Fax)

Attorney for Applicant(s)